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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,852	12/21/2000	Charles A. Eldering	T721-19	8089

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME  
6206 KELLERS CHURCH ROAD  
PIPERSVILLE, PA 18947

EXAMINER
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SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,852

Applicant(s)

ELDERING, CHARLES A.

Examiner

James Sheleheda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6,55,56,59,60,75,78,79,90 and 91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6,55,56,59,60,75,78,79,90 and 91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/21/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (Zigmond) (6,698,020) (of record) in view of Doherty (US2003/0200128A1) (of record).

As to claim 4, Zigmond discloses a subscriber system for inserting unscheduled advertisements into at least one channel of media signals (Fig. 7; column 6, lines 4-12, column 10, lines 64-67 and column 11, lines 1-3), the system comprising:

an ad insertion device (Fig. 5; ad insertion device, 80; wherein Fig. 5 is a detailed description of an insertion device used in Fig. 3) configured to determine an order in which an unscheduled advertisement (wherein the stored advertisements simply have rules associated with how to insert them, not specific time schedules; column 17, lines 21-28 and column 11, lines 31-49) is to be inserted into the at least one channel (column 11, lines 50-53 and lines 66-67, column 12, lines 1-9 and column 17, lines 21-25) and insert the unscheduled advertisement into the at least one channel according to the order (inserting the next selected advertisement when the trigger is detected; column 17, lines 21-31).

While Zigmond discloses a watchdog module (ad insertion device, 60) coupled to the ad insertion device (contained within the same device), the watchdog module configured to detect a change in program content display on the at least one channel (column 10, lines 40-47, column 11, lines 13-18 and column 12, lines 44-53) and output results to the ad insertion device (column 11, lines 13-18 and column 10, lines 40-47), such that the ad insertion device modifies the selection process (column 10, lines 40-47 and column 11, lines 13-17) and wherein an order for a next unscheduled advertisement is selected (column 17, lines 21-25), he fails to specifically disclose determining an order in which advertisements are to be inserted and modifying the order based on a detected change.

In an analogous art, Doherty discloses a system for displaying targeted advertising (Fig. 1; paragraph 25, lines 1-6) wherein a scheduler (Fig. 1, 140) assembles a schedule (order for ads to be inserted; paragraph 29), based upon advertisement priorities (paragraph 40), to determine the order in which advertisements are displayed (paragraph 38) and modifying the order based upon user action (paragraph 30) for the typical benefit of ensuring that advertisements are properly prepared when needed for output (paragraph 28, lines 1-11 and paragraph 38, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include determining an order in which advertisements are to be inserted and modifying the order based on a detected change, as taught by Doherty, for the typical advantage of ensuring that advertisements

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are properly prepared for display when needed thereby promoting efficient advertisement delivery.

As to claim 5, Zigmond and Doherty disclose a remote control device (see Zigmond at Fig. 8; input device, 150) in communication with the watchdog module (see Zigmond at column 9, lines 21-30 and lines 52-55), wherein the watchdog module detects change in the program content based on outputs from the remote control device (wherein the current program type, selected by the user, is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18 and column 12, lines 44-53).

As to claim 6, Zigmond and Doherty disclose wherein said watchdog module detects change in the program content based on program information (monitoring the current program being viewed; see Zigmond at column 9, lines 21-30 and lines 52-55 column 12, lines 44-67 and column 13, lines 1-6) and outputs received from the remote control device (wherein the current program is inherently based upon the current channel selection; see Zigmond at column 9, lines 21-30 and column 12, lines 44-66 and Fig. 8).

As to claim 55, Zigmond and Doherty disclose wherein said ad insertion device determines if a particular change in the currently displayed program content (wherein the current program the user has selected is monitored for ad selection; see Zigmond at

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column 10, lines 40-47, column 11, lines 13-18, column 12, lines 44-column 13, line 14) is sufficient to modify the order (see Doherty at paragraph 30).

As to claim 56, Zigmond and Doherty disclose a tuner (wherein a broadcast television receiver inherently contains a tuner; see Zigmond at column 7, lines 13-25) configured to tune to a channel selected by the subscriber (column 9, lines 21-28 and column 13, lines 12-28), wherein said watchdog module detects change in program content (see Zigmond at column 9, lines 21-28 and column 13, lines 12-28) by monitoring what channel the tuner is tuned to (wherein channel changes, requiring tuning to a new channel, are monitored; see Zigmond at column 9, lines 21-28 and column 13, lines 12-28).

As to claim 59, Zigmond and Doherty disclose a profiler (viewer and system information, 82) configured to process subscriber interactions and generate a viewing session profile (see Zigmond at column 9, lines 65-67, column 10, lines 1-3 and lines 36-47 and column 11, lines 13-18), wherein the viewing session profile defines characteristics related to a subscriber for a viewing session (preferred channels and programs; see Zigmond at column 10, lines 40-47 and column 11, lines 15-18).

As to claim 60, Zigmond and Doherty disclose wherein said watchdog module detects changes to viewing session profiles (see Zigmond at column 10, lines 40-47) and wherein the ad insertion device also modifies the order (modifying the order based

upon user action; see Doherty at paragraph 30) based on changes to the viewing session profiles (see Zigmond at column 10, lines 40-47 and column 11, lines 13-17).

As to claim 90, Zigmond discloses a method of presenting targeted advertisements to a subscriber viewing program content on a display device (Fig. 7; column 6, lines 4-12, column 10, lines 64-67 and column 11, lines 1-3), the system comprising:

- detecting an advertisement space associated with the program content (column 15, lines 35-44);

- presenting the targeted advertisements to the subscriber in the detected advertisement space (column 15, lines 52-65); and

- detecting a change in program content currently being displayed to the subscriber (wherein the current program the user has selected is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18, column 12, lines 44-column 13, line 14).

While Zigmond discloses unscheduled targeted advertisements to be presented to the subscriber (wherein the stored advertisements simply have rules associated with how to insert them, not specific time schedules; column 17, lines 21-28 and column 11, lines 31-49) and detecting a change in program content (wherein the current program the user has selected is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18, column 12, lines 44-column 13, line 14) and selecting an advertisement based upon a change in program content currently being displayed to the

subscriber (selecting the next ad based upon the new currently viewed program; column 10, lines 40-47 and column 11, lines 13-17 and column 12, line 44-column 13, line 14), he fails to specifically disclose generating a queue indicating the order in which advertisements are to be presented and reordering the queue according to the detected change.

In an analogous art, Doherty discloses a system for displaying targeted advertising (Fig. 1; paragraph 25, lines 1-6) wherein a scheduler (Fig. 1, 140) assembles a schedule (order for ads to be inserted; paragraph 29), based upon advertisement priorities (paragraph 40), to determine the order in which advertisements are displayed (paragraph 38) and modifying the order based upon user action (paragraph 30) for the typical benefit of ensuring that advertisements are properly prepared when needed for output (paragraph 28, lines 1-11 and paragraph 38, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include determining an order in which advertisements are to be inserted and modifying the order based on a detected change, as taught by Doherty, for the typical advantage of ensuring that advertisements are properly prepared for display when needed thereby promoting efficient advertisement delivery.



As to claim 75, Zigmond and Doherty disclose wherein said detecting occurs by monitoring what channel the subscriber is viewing (see Zigmond at column 9, lines 21-28 and column 12, line 44-column 13, line 28).

As to claim 78, Zigmond and Doherty disclose profiling subscriber interactions (contained within viewer and system information, 82) in order to generate a viewing session profile (see Zigmond at column 9, lines 65-67, column 10, lines 1-3 and lines 36-47 and column 11, lines 13-18), wherein the viewing session profile defines characteristics related to a subscriber for a viewing session (preferred channels and programs; see Zigmond at column 10, lines 40-47 and column 11, lines 15-18).

As to claim 79, Zigmond and Doherty disclose detecting changes to viewing session profiles (see Zigmond at column 10, lines 40-47) and wherein reordering (modifying the order based upon user action; see Doherty at paragraph 30) is also based on changes to the viewing session profiles (see Zigmond at column 10, lines 40-47 and column 11, lines 13-17).

As to claim 91, Zigmond and Doherty disclose wherein the queue is reordered in real time (wherein the schedule is modified as interactions are detected; see Doherty at paragraphs 30 and 25).

***Response to Arguments***

3. Applicant's arguments filed 03/21/05 have been fully considered but they are not persuasive.

a. On page 8, applicant argues that Zigmond does not use or insert "unscheduled" advertisements, as his ads are associated with a particular advertisement space, time slot and/or program content.

In response, Zigmond discloses downloading a plurality of advertisements with parameters detailing what type of advertisement it is (column 12, lines 15-32 and column 11, lines 37-42). There is no set schedule to insert these advertisements at any particular time. Ad selection rules are then used to properly match an advertisement with viewer information or program content information (column 11, lines 42-49). As the advertisements of Zigmond are specifically not scheduled in advance, as they are not selected for insertion until a television channel is being received and displayed (see Fig. 6; column 17, lines 21-32), they more than meet the broad claim limitation of "unscheduled".

b. On page 9, applicant argues that Doherty generates a definite time-based schedule of which and when ads are to be inserted, and therefore doesn't teach inserting unscheduled advertisements.

In response, as indicated in the rejections above, Zigmond discloses receiving and storing a plurality of *unscheduled* advertisements and selecting a *single* advertisement to insert into the next available ad slot. Doherty has simply

been relied upon to teach utilizing an ad queue containing an ordered list of how to insert the next *several* advertisements.

The combination of Zigmond and Doherty then teaches selecting a plurality of unscheduled advertisements from the received unscheduled ads to be inserted next.

c. On page 9, of applicant's response, applicant argues that Doherty teaches away from the use of a queue.

In response, it is noted that the "schedule" defined by Doherty is simply a list defining the order to insert ads, which is "more flexible" and will prioritize ads at a particular instant in time (i.e. since the last user interaction; paragraph 25, lines 8-35), and thus meets the claim limitations. Doherty's choice of different language doesn't negate the fact that his "schedule" clearly meets the current claim limitations.

d. On page 12, applicant argues that the current conditions which Doherty's system uses to prioritize advertisements and generate a schedule is not based on a change in displayed program content.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

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F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response, Doherty discloses creating a "schedule" listing a plurality of upcoming advertisements to be displayed (paragraphs 29 and 38) and altering that schedule based upon **user interactions** (paragraph 30).

Zigmond, as the base reference, specifically teaches selecting advertisements based upon the current viewed program (column 12, line 44-column 13, line 17) and monitoring user interactions which includes **program and channel changes** (column 10, lines 40-47, column 11, lines 13-17 and column 13, lines 7-27).

It is combination of Zigmond with Doherty which teaches reordering the advertisements based upon changes in program content.

e. As to applicant's arguments on page 10, see the rejections and (a)-(d) above.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda  
Patent Examiner  
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JS

  
VIVEK SRIVASTAVA  
PRIMARY EXAMINER